



PATENT TRADEMARK OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

DANLI WANG, MATTHEW T. SCHOLZ,
DONG-WEI ZHU and TRIET M. LU

Serial No.: 10/052,158
Filed: January 16, 2002

For: FILM-FORMING
COMPOSITIONS AND
METHODS

Group Art Unit: 1616

Examiner: S. Dodson

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

In response to the Office Action dated August 13, 2003, in which the Examiner applied a restriction requirement to Claims 1-49 (Group I); Claims 50-58 (Group II) and Claims 59 and 60 (Group III). Applicants hereby elect Group I (i.e., claims 1-49) with traverse, and respectfully request reconsideration and withdrawal of the restriction requirement.

The Office Action states that the inventions are distinct because the claims of Group I are unrelated to the claims of Groups II and III. The inventions are considered distinct if it can be shown that: 1) the inventions are not capable of use together; 2) the inventions have different modes of operation; 3) the inventions have different functions; or 4) the inventions have different effects. In this case, the Examiner states that the inventions have different functions.

Applicants submit the claims of Groups I, II and III are so interrelated that a search of one group of claims will reveal art to the other. Moreover, the classification of Groups I, II and III claims in different classes and subclasses is not sufficient grounds to require restriction.

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED
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Docket No.: 57339US002

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Were restriction to be effected between the claims in Groups I, II and III, a separate examination of the claims in Groups I, II and III would require substantial duplication of work on the part of the U.S. Patent and Trademark Office. Even though some additional consideration would be necessary, the scope of analysis of novelty of all the claims of Groups I, II and III would have to be as rigorous as when only the claims of Group I were being considered by themselves. This duplication of effort would not be warranted where these claims of different categories are so interrelated. Therefore, Applicants respectfully request reconsideration and withdrawal of the restriction requirement.

If a telephonic interview with the Applicants' undersigned representative would be helpful in resolving any questions, the Examiner is invited to contact the undersigned at (651) 733-2180.

Respectfully submitted,

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Dated: August 26, 2003